Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 10, 11, 25, 26, 40, 41, and 58-63 are pending in the application, with claims 10, 25, 40, 58, 60 and 62 being the independent claims. Claims 12, 27 and 42 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 40 and 62 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Support for Amended Claims

Support for amended claims 40 and 62 can be found throughout the specification, for example, at page 8, lines 6-12.

II. Double Patenting

Claims 10-12, 25-27 and 58-61 were rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1, 2, 10 and 11 of U.S. Patent No. 6,323,218 ("the '218 patent"). *See* Paper No. 14, page 3. Applicants respectfully traverse this rejection.

The Examiner is reminded that 35 U.S.C. § 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made as a

reference against any divisional application, if the divisional application is filed before the issuance of the patent. *See* 35 U.S.C. § 121, third sentence; *see also* MPEP § 804.01.

The present application is a divisional of U.S. Patent Application No. 09/038,154, which issued as the '218 patent. The present application was filed prior to the issuance of the '218 patent and was filed as a result of a restriction requirement that was made in U.S. Patent Application No. 09/038,154. (The currently pending claims correspond to "Group II" as set forth in the restriction requirement in the parent application.) Thus, under 35 U.S.C. § 121, the '218 patent cannot be used in a double patenting rejection (statutory or obviousness-type) against the claims in the currently pending application.

Moreover, the Examiner is reminded that a statutory double patenting rejection cannot be properly made if, for example, there is an embodiment of the invention that falls within the scope of a claim in the application but does not fall within the scope of a corresponding claim in the patent, or *vice versa*. *See In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *see also* MPEP § 804, II, A. Since the claims of the '218 patent encompass embodiments that do not fall within the scope of the corresponding claims in the present application, the claims do not define the "same invention" and a statutory double patenting rejection cannot be properly made.[1]

Applicants respectfully request that the rejection for statutory double patenting be reconsidered and withdrawn.

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[1]The Examiner stated that "the present application reads on the patented application." *See* Paper No. 14, page 3. Whether a pending application reads on a patented application is not the proper test for a statutory double patenting rejection. *See* MPEP § 804, II, A.

III. Claim Rejections Under 35 U.S.C. § 102

Claims 40-42, 62 and 63 were rejected under 35 U.S.C. § 102(a) as being anticipated by Crow *et al.*, U.S. Patent No. 6,022,879 ("Crow"). *See* Paper No. 14, page 4. Applicants respectfully traverse this rejection.

As an initial matter, Applicants note that Crow issued on February 8, 2000. A rejection under 35 U.S.C. § 102(a) is proper only if "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." *See* 35 U.S.C. § 102(a). The effective filing date of the present application is well before February 8, 2000. Thus, Crow cannot be used in a rejection under 35 U.S.C. § 102(a).

Notwithstanding the fact that Crow is not prior art under § 102(a), Applicants note that Crow does not include all of the elements of any of the claims currently presented. In particular, the amended versions of claims 40 and 62 are directed to pharmaceutical compositions for treatment of conditions caused by amyloidosis, Aβ-mediated ROS formation, or both, comprising (a) a chelator specific for copper (claims 40 and 41) or a hydrophobic derivative of a chelator specific for the reduced form of copper (claims 62 and 63), and (b) clioquinol, together with one or more pharmaceutically acceptable carriers or diluents. Crow does not teach methods or compositions that comprise clioquinol. Thus, Crow cannot and does not anticipate the currently pending claims.

Applicants respectfully request that the rejection under 35 U.S.C. § 102(a) be reconsidered and withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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